

Appln. No. 10/764,395
Amendment dated April 11, 2005
Reply to Office Action mailed January 12, 2005

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claim 20 remains in this application. Claims 1 through 19 and 21 through 22 have been cancelled. No claims have been withdrawn or added.

Paragraphs 2 through 9 of the Office Action

Claims 1 and 9 have been rejected under 35 U.S.C. §102(b) as being anticipated by US 5345784 (Bazemore et al.).

Claims 2 through 4 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 3715895 (Devlin).

Claim 5 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 4981234 (Slaughter).

Claims 6 and 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 5005374 (Spitler).

Claims 10 through 13 and 22 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 181909 (Chinnock).

Claims 14 and 16 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 3715895 (Devlin), US 4981234 (Slaughter) and US 5005374 (Spitler).

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Claims 17 through 20 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 3715895 (Devlin), US 4981234 (Slaughter) and US 5005374 (Spitler) as applied to claim 14, and further in view of US 181909 (Chinnock).

Claim 21 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over US 5345784 (Bazemore et al.) in view of US 5579946 (Rowan et al.).

Claim 20 has been written into independent form with all requirements of claims 14, 18 and 19, from which claim 20 previously depended. Claim 20 requires "said dome member of said cover assembly being substantially hemispherical shaped, said shell member of said cover assembly being substantially hemispherical shaped, said shell member having a radius less than a radius of said dome member such that said shell member is pivotable inside said dome member when said shell member is pivoted with respect to said lid member".

The rejection of the Office Action relies upon an allegedly obvious combination of the Bazemore et al., Devlin, Slaughter, Spitler, and Chinnock patents in an attempt to assemble the combination of elements required by applicant's claim 20. In particular, the Office Action states:

Chinnock teaches a cover assembly for an aperture, cap A, that is movable between a closed position and an open position, said open position permitting access through said aperture and said closed position selectively limiting access through said aperture. Cap A comprises a dome member b and a shell member a, said dome member b being positioned over a portion of an aperture, said shell member a being pivotally coupled such that said shell member a is for selectively covering the portion of said serving aperture not covered by said dome member b, said shell member a being nested within said dome member b to permit access to said aperture when said shell member a is pivoted. Said dome member b and shell member a are substantially hemispherical in shape, said shell member a having a radius less than a radius of said dome member b such that said shell

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member is pivotable inside said dome member b when said shell member a is pivoted.

It is significant to note that the courts have recognized that most elements of inventions can be found somewhere in the prior art.

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

And thus the ability to find each one of the claimed elements in the prior art does not in and of itself negate patentability.

Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The Office Action sets forth a number of reasons that are alleged to support the combinations of the various parts of the cited references. It is alleged in the Office Action that (emphasis added):

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the lid member disclosed by Bazemore et al. with the cover assembly taught by Chinnock in order to provide a means for closing the serving aperture on said lid member such that undesirables (e.g. dust, germs, insects, spiders, etc.) would be prevented from contaminating the contents of the interior bowl member when the aperture is not in use. While any suitable cap known in the art (e.g. detachable flap or plug) could have been used for this purpose, Chinnock expressly teaches that the shell and dome covering offers the additional advantage of obviating the chance of misplacing a removable cap (see paragraph 7).

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However, the Chinnock patent is directed to an "IMPROVEMENT IN LAMP-FILLING TUBES", and its "advantages" are particularly addressed to the problems encountered in lamps. See Chinnock at col. 1, where it states (emphasis added):

This invention relates to certain improvements in filling-caps for lamps, its object being to provide a cap which may be readily opened for the purpose of filling the lamp without removing any portion of the same, and thus avoid the liability of losing or misplacing the same—a serious objection to the ordinary removable caps commonly employed for the purpose.

So, while the Chinnock patent does point out an advantage for the disclosed structure, it is an advantage or purpose directed to lamps and one of ordinary skill in the art understands that this is an advantage that is obtained in filling lamps that have no other opening, and in this case hold a flammable liquid to be burned, and not in food bowl containers in a position on a lid that is removable from the container. The Office Action suggests further "advantages" of the allegedly obvious combination, including "closing the serving aperture on said lid member such that undesirables (e.g. dust, germs, insects, spiders, etc.) would be prevented from contaminating the contents of the interior bowl member when the aperture is not in use". However, these reasons do not appear to be taken from the prior art, but from an ex post facto analysis of the combination of the features disclosed in the applicant's application, and possible benefits of the applicant's invention applied to the prior art parts.

A motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

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In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Absent a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's disclosure has provided the motivation for making the combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action would not motivate one skilled in the art to arrive at the applicant's claimed invention.


Withdrawal of the §103(a) rejection of claim 20 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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